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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,534	05/02/2001	Peter Van Horne	CISCO-4667	6599
7590 12/02/2008				
David B. Ritchie THELEN, REID & PRIEST LLP P.O. Box 640640 San Jose, CA 95164-0640				
EXAMINER				
OBEID, MAMON A				
ART UNIT		PAPER NUMBER		
3621				
MAIL DATE		DELIVERY MODE		
12/02/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: PETER VAN HORNE, KEITH OLSON, KEVIN MILLER

Application No. 09/848,534
Technology Center 3621

Mailed:

Before KRISTA ZELE *Deputy Chief Appeals Administrator*
ZELE, *Deputy Chief Appeals Administrator*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on September 29, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

EXAMINER'S ANSWER

GROUND'S OF REJECTION TO BE REVIEWED UPON APPEAL

A review of the file finds that the grounds of rejection to be reviewed on appeal of the claims as provided in the Examiner's Answer mailed December 27, 2007 under the heading "Grounds of rejection to be Reviewed on Appeal" is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection to be reviewed on appeal as provided in the Examiner's Answer must be consistent with the last Office action of record, including any Advisory

action responsive to any after final submissions. Furthermore, the examiner must provide a clear statement of whether examiner agrees or disagrees with the statement of grounds of rejection to be reviewed as set forth in the brief and an explanation of any disagreement. *See also Manual of Patent Examining Procedure (MPEP) § 1207.02* (8th ed. Rev. 6, Sept 2007) for details.

A review of the Examiner's Answer finds that it is unclear what rejected claims are on appeal as compared to the Appeal Brief. The Appeal Brief dated September 24, 2007 and the Final Rejection dated April 23, 2007 states: Claims 39-54, 58-73, 77, 78 80 and 81 are rejected under 35 U.S.C. 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner's Answer dated December 27, 2007 states: Claims 58-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner's Answer does not clearly address differences between rejections set forth in the Examiner's Answer and those addressed in the Appeal Brief.

Clarification of the record is required for all Grounds of rejection to be reviewed on appeal for all claims. It is unclear if some of the 112-2nd paragraph rejections have been withdrawn by the examiner. Therefore, clarification is required.

Accordingly, it is **ORDERED** that the application be returned to the Examiner:

- 1) to vacate the Examiner's Answer mailed December 27, 2007;
- 2) to generate a new Examiner's Answer setting forth the correct Grounds of rejection to be reviewed on appeal OR to include a clear statement if any grounds of rejection of claims have been withdrawn, and to correct other sections of the Answer as may be required; and
- 3) such further action as may be required.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

KZ/dw

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